

### REMARKS

In the Office Action dated July 29, 2004, claims 1-4, 8, 19-24, 27-28, 30, 33, 35, 37, 39, and 41 were rejected under 35 U.S.C. § 102 over U.S. Patent No. 6,415,318 (Aggarwal) and incorporated U.S. Patent No. 5,943,478 (Aggarwal 2); claims 5-6 were rejected under 35 U.S.C. § 103 over Aggarwal in view of U.S. Patent No. 6,430,604 (Ogle); claims 7 and 29 were rejected under 35 U.S.C. § 103 over Aggarwal and U.S. Patent No. 6,038,602 (Ishikawa); and claims 32, 34, 36, 38, 40, and 42 were rejected under 35 U.S.C. § 103 over Aggarwal, and U.S. Patent No. 5,764,916 (Busey).

Independent claims 1 and 2 have been cancelled, without prejudice, to render the rejection of those claims moot.

Dependent claims 5, 7, 29, 34, 36, and 40 have been amended from dependent form to independent form, with the scope of each claim remaining *unchanged*.

Claim 5 was rejected as being obvious over the asserted combination of Aggarwal and Ogle. The term “established connection” in the last line of claim 5 has been replaced with “established link” to address a minor typographical error. The term “link” is used in other parts of the claim. Thus, the amendment of “established connection” to “establish link” merely changes the form of the claim without affecting its scope.

A *prima facie* case of obviousness has not been established with respect to claim 5 for at least the reason that there existed no motivation or suggestion to combine the teachings of Aggarwal and Ogle. See M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 2), at 2100-129.

As conceded by the Office Action, Aggarwal does not teach sending a message to a predetermined communications device other than the second terminal if the second terminal does not have an established link with the second community server. 7/29/2004 Office Action at 7. However, the Office Action relied upon Ogle as teaching this missing feature. This combination of Aggarwal and Ogle is improper, as a person of ordinary skill in the art would not have been motivated to combine the teachings of Aggarwal and Ogle to achieve the claimed invention.

The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As the Federal Circuit has stated, “virtually all [inventions] are combinations of old elements.” *In re Rouffet*, 149 F.3d 1350, 1357,

47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). “Most, if not all, inventions are combinations and mostly of old elements.” *Id.*

Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

*Id.*

In this case, Aggarwal teaches that the destination client (client B in the example of Fig. 3 of Aggarwal) must be online for a messaging server B to transmit a received message 100 to the client B. Aggarwal, 9:60-62. In fact, Aggarwal goes into great detail regarding how the online status of clients can be maintained and communicated to other clients. *See* Aggarwal, 10:47-57, 11:8-19, 11:50-64. As described in these passages of Aggarwal, the online status property of each client is communicated to contact lists such that a sending client would be able to determine whether a destination client is logged on or not to its messaging server. By referring to a contact list, a user “can immediately know whether particular correspondents are online and available to engage in real-time communication over the Internet.” Aggarwal, 11:16-19.

There is absolutely no suggestion of any desirability to incorporate the teachings of Ogle into the system of Aggarwal. In fact, the teachings of Aggarwal are inconsistent with the teachings of Ogle (and the subject matter of claim 5). The teaching of Aggarwal that requires users to be logged on to participate in an instant messaging session is inconsistent with the teachings of Ogle regarding alternative actions taken by an instant messaging system (IMS) in response to detecting that a user is not logged on to the IMS. Ogle proposes that users may register one or more alternative message delivery mechanisms through which they are available as an alternative to an instant messaging system. In contrast, Aggarwal teaches a solution (which requires that a client be logged on to participate in an instant messaging session) that has absolutely no need for the system described in Ogle. If a destination client in Aggarwal is not logged on (based on monitoring a contact list), then a sending client would not even attempt to communicate with the destination client. Therefore, a person of ordinary skill in the art would

not have been led to incorporate the IMS system of Ogle into the Aggarwal system, as there did not exist any need or desirability for the alternative device contacting mechanism of Ogle into Aggarwal.

In view of the foregoing, it is respectfully submitted that no motivation or suggestion existed to combine the teachings of Aggarwal and Ogle to achieve the claimed invention. A *prima facie* case of obviousness has thus not been established with respect to claim 5.

Independent claims 19 and 20 have been amended to recite a controller or system to send a message to an alternative destination if the original destination is not logged on. Therefore, claims 19 and 20 are allowable over Aggarwal and Ogle for reasons similar to those as for claim 5.

Independent claim 7 was rejected as being obvious over Aggarwal in view of Ishikawa. It is respectfully submitted that no motivation or suggestion existed to combine the teachings of Aggarwal and Ishikawa.

As discussed above, Aggarwal teaches that a destination client must be logged on or online before the messaging server transmits an instant messaging message to the client. The online status of clients are maintained in contact lists to enable users of clients to know whether potential recipient clients are online. Aggarwal, 10:47-49. Notification of changes in the online status of clients can be communicated from one network to another. Aggarwal, 10:53-55. "By referring to contact list 120, the user of client A can immediately know whether particular correspondents are online and therefore available to engage in real-time communication over the Internet." Aggarwal, 11:16-19. In other words, Aggarwal teaches that a destination or recipient client must be logged on or online before a sending client can engage in an instant messaging session with the destination client. There is absolutely no teaching whatsoever of any desirability to incorporate the reverse log on feature of Ishikawa into the system of Aggarwal. In Aggarwal, if a destination client is not logged on, then a sending client would not even attempt to establish an instant messaging session with the destination client. Thus, there would be absolutely no need for the technique of Ishikawa in the system of Aggarwal.

Moreover, the teaching in Aggarwal that users must be online or logged on before an instant messaging session can be established is inconsistent with the teachings of Ishikawa relating to the reverse log on to establish an IP connection.

In view of the foregoing, it is respectfully submitted that a person of ordinary skill in the art would not have been motivated to combine the teachings of Aggarwal and Ishikawa. A *prima facie* case of obviousness has thus not been established with respect to claim 7.

Independent claim 29 is allowable for similar reasons as claim 7.

Independent claim 34 was rejected as being obvious over the asserted combination of Aggarwal and Busey. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 34 for at least the reason that no motivation or suggestion existed to combine the teachings of Aggarwal and Busey to achieve the claimed invention.

As conceded by the Office Action, Aggarwal fails to disclose providing a response, from a second community server, to the first terminal (which is coupled to the first community server) to present a web page in a web browser on the first terminal, and receiving a text message of the real-time, text-based messaging session originated from the web browser on the first terminal.

Thus, according to claim 34, the server in the *second* community presents a response to the first terminal of the *first community* to present a web page in a web browser on the first terminal. Although the Office Action cited Busey as teaching such a feature, it is respectfully submitted that this assertion is incorrect. Although Busey teaches the use of a web browser to establish chat sessions, Busey is a one-service provider system (multiple chat clients establish TCP/IP connections to a host computer). Busey, 3:24-29. Thus, it would be impossible for Busey to teach providing a response from a *second* community server to a first terminal coupled to a *first* community server to present a web page in a web browser on the first terminal. Because Busey does not teach multiple service providers and associated servers, such communication between different communities is clearly not taught or suggested by Busey.

The Office Action pointed to column 9, lines 66-67, of Aggarwal as teaching the act of providing a response from the second community server to the first terminal. This is factually incorrect, as the cited passage refers to the client B (which is the destination client) receiving message 100 and popping up a window on the user's screen. On the other hand, in claim 34, the

second community server is the *destination server*, whereas the first terminal is the *sending terminal*, in the context of claim 34. Therefore, what occurs in claim 34 is that the *destination* community server sends a response to the *sending* terminal to present a web page in a web browser on the *sending* terminal. On the other hand, in Aggarwal, according to the cited passage in column 9, lines 66-67, client B (the *destination* client) pops up a window in response to a message from the *destination* messaging server.

In view of the foregoing, it is respectfully submitted that even if Aggarwal and Busey can be properly combined, the asserted combination of Aggarwal and Busey fails to teach or suggest all elements of claim 34. A *prima facie* case of obviousness has thus not been established with respect to claim 34 for at least this reason.

Independent claim 36 also recites that the controller (that is part of a *destination* server) is adapted to communicate a web page for display on the entity (which is the *sending* entity associated with the sending community). Thus, claim 36 is allowable over the asserted combination of Aggarwal and Busey for reasons similar to those for claim 34.

Independent claim 40 recites that a system (which is the *destination* system) provides a web page for display at a subscriber terminal (that is the *sending* terminal) in the second community. Thus, claim 40 is allowable for reasons similar to those as for claim 34.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

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Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0010US).

Respectfully submitted,

Date: \_\_\_\_\_

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Dan C. Hu  
Registration No. 40,025  
TROP, PRUNER & HU, P.C.  
8554 Katy Freeway, Suite 100  
Houston, TX 77024  
Telephone: (713) 468-8880  
Facsimile: (713) 468-8883